



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,636	12/12/2003	Soo-Jin Park	P56916	1649

7590 12/22/2005

Robert E. Bushnell
Suite 300
1522 K Street, N.W.
Washington, DC 20005

EXAMINER

DESAI, RITA J

ART UNIT	PAPER NUMBER
----------	--------------

1625

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,636

Applicant(s)

PARK ET AL.

Examiner

Rita J. Desai

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

DETAILED ACTION

Response to arguments filed 9/21/05.

The restriction /election made in paper number 1/7/ 2005 is as follows

the groups and applicants have elected and prosecuted election was made with respect to prosecute the invention of Group I, claims 1-4, in part, 5-10 and 12-14, drawn to compounds of formula I given by formulas 2-7 in claims 5-10. Claims 1-4 in part and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicants had elected group I.

Applicants have not amended the claims to the elected group and have not cancelled the non-elected subject matter.

Claim Rejection –35 USC 103.

In paper number 1/2005 a rejection under 35 USC 103 was made over ;656 publication.

The compounds disclosed were positional isomers and had the same properties.

Isomers are known to have similar properties unless there is a showing of unexpected results.

Applicants arguments that in the specifications page 3 lines 7-12 states that the prior art still require improvement in luminescent efficiency and film stability.

Applicants have not shown by side by side comparison that their compounds do have a considerable improved luminescent efficiency and film stability. The examiner has not disregarded the information but does not think that the statement indicates an unexpected result.!

Thus in the absence of a clear showing the rejection stands.

Art Unit: 1625

Applicants arguments that in *In re Papesch* 315 F.2d 381, 137 USPQ 43 (CCPA 1963) the affidavit evidence was sufficient because it was a comparison between **no** anti-inflammatory activity and anti-inflammatory activity.

In re Wiechert 370 F.2d 927, 152 USPQ 247 (CCPA 1967) shows a 7 fold improvement which would be unexpected.

Applicants claim that their compounds are an improvement, but there is no showing as to the extent of improvement. Thus the rejection still stands.

The rejection is not based on isomerism alone but also the fact that it has the same properties.

Also applicants claim 1 does not indicate the point of attachment to the various X groups hence could also include the prior art compounds.

Thus it is a *prima facie* obvious rejection.

Claim Rejection –35 USC 112

Applicants arguments are not convincing. Applicants have only disclosed compounds wherein the R1-R10 are all H. Applicants claims are drawn to R1-R10 to be various groups including upto C30 hetero and non-hetero groups.

There are no working examples and the art is highly unpredictable. When the art is so unpredictable that even a methyl Vs hydrogen changes the properties as evident by caffeine and theophylline, applicants should have more guidance as to exactly which substituents are there and at which position. Without any guidance it would require an undue amount of experimentation to arrive at the compounds of the invention.

Thus the rejection still stands.

Art Unit: 1625

Claims 1, 7, 9, 10 and 12-14 rejected under 35 USC 112 second para since applicants have amended the claims.

Applicants have not responded to the Double Patenting rejection made in paper number 1/2005.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

Art Unit: 1625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
December 16, 2005

RJ Desai
12/16/05